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EXAMINER

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3727

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 14

Application Number: 09/941,029
Filing Date: August 28, 2001
Appellant(s): HATCH, MELVIN

Robert W. Becker
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/31/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The amendment after final rejection filed on 4/15/03 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

Appellant's brief presents arguments relating to whether the drawing proposal for Fig. 1a as submitted with the April 15, 2003 amendment contains new matter. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201. Moreover, this issue was petitioned on 11/04/03 and dismissed.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 5, 9, 10, and 11 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

1,651,346	Golden	11-1927
2,691,816	Siegel	10-1954
2,285,698	Emmer	6-1942
2,552,051	Margulies	5-1951
1,141,846	Spremulli et al	6-1915
4,726,553	Wischusen, III	2-1988
5,127,188	Shaw wt al	7-1992

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4, 6, 7, 11-13, 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Golden (US 1,651,346). Regarding claim 1, looking at Fig. 2 of Golden, the outer portion is a the part where the lead line 1 touches the base, the inner portion is the part where lead line 2 touches the base which is below the ridge that joins the inner and outer portions. The inner portion has no apertures as seen in Figs. 2 and 3. The inner portion is concavely curved at the rounded corner of the inner portion adjacent the corner of the jar as seen in Fig. 2. The inner portion is also concavely curved in a horizontal plane since it accepts the round bottom jar. The base is the rounded part at the end of the outer portion for placement on a heating unit. The structure is capable of

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being placed on a heating element. The intended use does not require any structure that is not in the reference. The outer portion 1 extends away from the upper location of the inner portion and merges with the rounded lip base. See Col. 1, line 38, where it is stated that the base is metal. The structure of Golden holds a vessel with a round or curved bottom as seen in Fig. 2. The bottom of the vessel of Golden is curved in at its outer periphery. Regarding claim 4, see Figs. 2 and 3, where the support is made from a single sheet of metal since there are no seams or joints as seen in the cross-section views. Moreover, this limitation does not require any structure that is not in the Golden reference. Regarding claim 6, see Figs. 2 and 3, where the outer portion tapers outwardly from the upper location where the outer portion meets the inner portion at the ridge. Regarding claim 7, see Figs. 2 and 3, where the outer portion extends essentially cylindrically from the upper location towards the base. The essentially allows for variation from cylindrical. The outer portion of the reference is tapered similarly to the outer portion of the instant invention and satisfies the limitation. Regarding claim 11, the base extends radially outward from where the outer portion merges with the base. See Figs. 2 and 3, where the part of the rounded corner that merges with the outer portion is radially outward of the outer portion. Regarding claim 12, the support of Golden is a monolithic component. The cross-sections of Figs. 2 and 3 do not show any joints or seams. Regarding claim 13, see Figs. 2 and 3 where the base is formed by a lower part of the outer portion remote from the upper location of the inner portion as seen in Figs. 2 and 3. The base is the rounded portion at the bottom of the outer portion. Regarding claim 15, the bottom of the inner portion has a small flat section.

The relative term small does not define over the reference to Golden. Regarding claim 16, the bottom of the inner portion is spaced from the plane of the base. Regarding claim 17, the structure of Golden is capable of being placed on an electric hot plate having a flat surface. The base claim from which claim 17 depends, clearly states that the support is for placement on a heating element. The intended use does not require any structure that is not in the reference. Moreover, the structure of Golden is capable of being placed on an electric heating element that has a flat surface. Claim 17 does not require the combination of the heating element and the support. Regarding claim 18, see Figs. 2 and 3, where the inner and the outer portions define a space that is open in a direction away from where the inner and outer portions adjoin each one another. The space is the open area under the ridge where the inner and outer portions meet.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden in view of Shaw et al (US 5,127,188). Regarding claims 2 and 3, Golden does not teach the specific metals. Shaw et al, as seen in Col. 2, lines 2-7, teaches a receptacle support that can be made of copper or aluminum. It would have been obvious to employ the copper and aluminum of Shaw et al in the support of Golden to employ durable and long lasting materials.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Golden in view of Siegel (US 2,691,816). Regarding claim 5, Golden does not teach making the support of a multi-layer metal sheet. Siegel, as seen in Col. 1, teaches making a multi-layer metal sheet with a thin layer of gold. It would have been obvious to

make the support of Golden a multi-layer metal as taught by Siegel to provide a more decorative structure or to enhance its visual appearance.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Golden in view of Emmer (US 2,285,698). Regarding claim 9, Golden teaches a rounded base instead of flat. Emmer, as seen in Fig. 1, teaches a support that has a flat outwardly extending base. It would have been obvious to employ the flat outwardly extending base of Emmer in the support of Golden to provide a more stable support.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Golden in view of Marguiles (US 2,552,051). Regarding claim 10, Golden does not teach the base being separate from the outer portion. Marguiles teaches a similar structure where the base is a separate member from the outer portion. It would have been obvious to make the base of Golden separate from the outer portion to provide another way of manufacturing the support.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Golden in view of Wischusen, III (US 4,726,553). Regarding claim 14, Golden teaches the outer portion being essentially cylindrical but does not teach the base being square. Wischusen, III, as seen in Figs. 1 and 4, teaches that a support similar to Golden that has an essentially cylindrical outer portion can have either a circular base or a square base. It would have been obvious to employ the square base of Wischusen in the support of Golden to provide an alternative or more stable configuration for the base as taught by Wischusen, III.

Claims 1, 4, 6-7, 11-13, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden in view of Spremulli et al (US 1,141,846). Regarding claim 1, to the degree that the bottom of the inner surface has to be convexly curved then the support of Golden does not teach this structure. Spremulli et al, as seen in Fig. 1, teaches a similar support where the bottom is curved for support a receptacle with a curved bottom. It would have been obvious to employ the convexly curved bottom of Spremulli et al in the support of Golden to support a convexly curved bottom vessel as taught by Spremulli et al. Looking at Fig. 2 of Golden, the outer portion is the part where the lead line 1 touches the base, the inner portion is the part where lead line 2 touches the base which is below the ridge that joins the inner and outer portions. The inner portion has no apertures as seen in Figs. 2 and 3. The inner portion is concavely curved at the rounded corner of the inner portion adjacent the corner of the jar as seen in Fig. 2. The inner portion is also concavely curved in a horizontal plane since it accepts the round bottom jar. The base is the rounded part at the end of the outer portion for placement on a heating unit. The structure is capable of being placed on a heating element. The intended use does not require any structure that is not in the reference. The outer portion 1 extends away from the upper location of the inner portion and merges with the rounded lip base. See Golden, col. 1, line 38, where it is stated that the base is metal. The modified structure of Golden holds a vessel with a round or curved bottom as seen in Fig. 2. The bottom of the vessel of Golden is curved at its outer periphery. Regarding claim 4, see Figs. 2 and 3, where the support is made from a single sheet of metal since there are no seams or joints as seen in the cross-

section views. Moreover, this limitation does not require any structure that is not in the Golden reference. Regarding claim 6, see Figs. 2 and 3, where the outer portion tapers outwardly from the upper location. Regarding claim 7, see Figs. 2 and 3, where the outer portion extends essentially cylindrically from the upper location towards the base. The essentially allows for variation from cylindrical. Regarding claim 8, the base, which is the rounded corner, is a continuous sheet without apertures. Regarding claim 11, the base extends radially outward from where the outer portion merges with the base. See Figs. 2 and 3, where the part of the rounded corner that merges with the outer portion is radially outward of the outer portion. Regarding claim 12, the modified support of Golden is a monolithic component. The cross-sections as seen in Figs. 2 and 3 of Golden do not show any joints or seams. Regarding claim 13, see Figs. 2 and 3 where the base is formed by a lower part of the outer portion remote from the upper location of the inner portion as seen in Figs. 2 and 3. The base is the rounded portion at the bottom of the outer portion. Regarding claim 15, the bottom of the inner portion of the modified support of Golden has is curved and has a small flat section in the center of the bottom as seen in Fig. 2 of Spremulli et al. Regarding claim 16, the bottom of the inner portion is spaced from the plane of the base. Regarding claim 17, the structure of Golden is capable of being placed on an electric hot plate having a flat surface. The base claim from which claim 17 depends, clearly states that the support is for placement on a heating element. The intended use does not require any structure that is not in the combination of references. Moreover, the structure of Golden is capable of being placed on an electric heating element that has a flat surface. Claim 17 does not require

the combination of the heating element and the support. Regarding claim 18, see Figs. 2 and 3, where the inner and the outer portions define a space that is open in a direction away from where the inner and outer portions adjoin each one another. The space is the open area under the ridge where the inner and outer portions meet.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden in view of Spremulli et al as applied to claim 1 above and further in view of Shaw et al (US 5,127,188). Regarding claims 2 and 3, the modified support of Golden does not teach the specific metals. Shaw et al, as seen in Col. 2, lines 2-7, teaches a receptacle support that can be made of copper or aluminum. It would have been obvious to employ the copper and aluminum of Shaw et al in the support of Golden to employ durable and long lasting materials.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Golden in view of Spremulli et al as applied to claim 1 above and further in view of Siegel (US 2,691,816). Regarding claim 5, the modified support of Golden does not teach making the support of a multi-layer metal sheet. Siegel, as seen in Col. 1, teaches making a multi-layer metal sheet with a thin layer of gold. It would have been obvious to make the modified support of Golden a multi-layer metal as taught by Siegel to provide a more decorative structure or to enhance its visual appearance.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Golden in view of Spremulli et al as applied to claim 1 above and further in view of Emmer (US 2,285,698). Regarding claim 9, the modified support of Golden teaches a rounded base instead of a flat base. Emmer, as seen in Fig. 1, teaches a support that has a flat

outwardly extending base. It would have been obvious to employ the flat outwardly extending base of Emmer in the modified support of Golden to provide a more stable support.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Golden in view of Spremulli et al as applied to claim 1 above and further in view of Marguiles (US 2,552,051). Regarding claim 10, the modified support of Golden does not teach the base being separate from the outer portion. Marguiles teaches a similar structure where the base is a separate member from the outer portion. It would have been obvious to make the base of Golden separate from the outer portion to provide another way of manufacturing the support.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Golden in view of Spremulli et al as applied to claim 1 above and further in view of Wischusen, III (US 4,726,553). Regarding claim 14, the modified support of Golden teaches the outer portion being essentially cylindrical but does not teach the base being square. Wischusen, III, as seen in Figs. 1 and 4, teaches that a support similar to Golden that has an essentially cylindrical outer portion can have either a circular base or a square base. It would have been obvious to employ the square base of Wischusen in the support of Golden to provide an alternative configuration for the base as taught by Wischusen, III.

(11) Response to Argument

In response to appellant's argument that the device of Golden is not a heat-conducting support, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The base of Golden thought it is intended for holding a cold sterilization fluid, is made of metal and is capable of conducting heat as required by the claims. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Appellant argues with respect to Golden that it does not teach all the limitations of the claim 1. See the above rejections where all the elements or limitations of claim 1 are set forth. Appellant specifically argues that the support surface of the inner surface must be concavely curved in light of the context of the instant application. This is incorrect. The claim does not even specify a support surface as a limitation. The claim is set up as an "or" statement. "Round or curved bottom" implies one or the other not both. The reference to Golden satisfies both limitations. The bottom of the vessel of Golden is round. Moreover, the inner surface of Golden is concavely curved in two directions, i.e. horizontally and vertically at the round inside corner. Though the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Appellant further argues that the device of Golden does not teach a

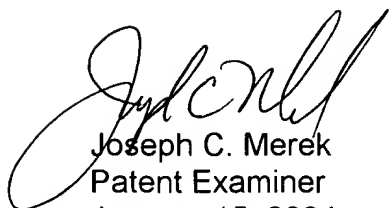
base that extends radially outwardly from the where said outer portion merges with said base. As seen in Fig. 2 and 3 of Golden the Rounded bottom edge is the base of the device of Golden. It is clear from these figures that the rounded lower edge extends radially outwardly from the outer portion.

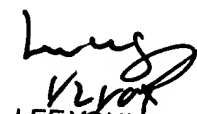
Appellant argues that there is no motivation for combining Siegel with Golden. This is incorrect. Siegel teaches manufacturing a metal sheet where there is a thin layer of rare metal over thicker layer(s) of inexpensive metals. It would have been obvious to employ the metal sheet of Siegel to replace the metal sheet of Golden to provide a decorative layer on the exterior of Golden to enhance the visual appearance of the device.

With respect to the rejection of Golden in view of Spremulli et al, appellant argues that Spremulli et al is non-analogous art and is not in the same field of endeavor as the instant invention. This is not the real issue with the rejection. The issue is if the two references are in the same field of endeavor. Golden teaches a support for a receptacle. Spremulli et al teaches a support for a receptacle. The receptacle of Golden is used for holding both a sterilizing solution and instruments or tools. The receptacle of Spremulli et al is used for holding garbage. The uses of each receptacle do not change the field of endeavor where the base of the device is for supporting the receptacle. Therefore the rejection is proper.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


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January 15, 2004


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